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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,676	03/03/2004	Takeshi Kokubo	SON-2934	2307
23353 7590 07/25/2008 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				
EXAMINER				
RAMAKRISHNANAH, MELUR				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,676

Applicant(s)

KOKUBO, TAKESHI

Examiner

Melur Ramakrishnaiah

Art Unit

2614

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4-25-2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-7 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-7, 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's disclosure does not have support for this claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-6, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe (US PAT: 5,987,609) in view of Yamao (US PAT: 7,200,220, filed 3-16-2000).

Regarding claim 5, Hasebe discloses a mobile terminal apparatus comprising: Storage means (13, fig. 3) for storing data (col. 4 lines 35-45), communication means (fig. 7) for receiving an electronic mail via a communication network and controller (11,

fig. 3) for erasing the specified data from the storage means (col. 7 lines 2-25; col. 6 lines 44-48; col. 7 lines 64-67; col. 8 lines 35-56).

Hasebe differs from claimed invention in that although he discloses user sending specified instructions to effect security functions of the mobile terminal by transmitting electronic mail to it (col. 6 lines 44-48), he does not specifically teach: controller for transmitting specified data to a specified server when a specified instruction is received from a user before erasing the data in the mobile terminal/portable terminal.

However, Yamao discloses portable telephone maintenance service system and service method which teaches the following: controller (15, fig. 1) for transmitting specified data to a specified data server (4, fig. 1) when a specified instruction is received from a device before erasing the data in the mobile terminal/portable terminal (col. 3, line 23 – col. 4, line 32; col. 7, lines 36-45).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Hasebe's system to provide for the following: controller for transmitting specified data to a specified data server when a specified instruction is received from a user before erasing the data in the mobile terminal/portable terminal as this arrangement would facilitate the user to latter download data to his terminal so that user does not have to recreate data that has been erased in the portable terminal as taught by Yamao (col. 2 lines 54-62).

Hasebe differs from claim 6 in that although he discloses: carrying out security functions based on information regarding sender of the received electronic mail previously registered in sender information (col. 7 lines 2-26; col. 6 lines 44-48), he

does not specifically teach: controller transmits the specified data to the server only under certain condition is fulfilled.

However, Yamao discloses the following: controller transmits the specified data to the server only under certain condition is fulfilled such as receiving instructions from a device connected to the portable terminal (col. 3, line 23 – col. 4, line 32; col. 7, lines 36-45).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Hasebe's system to provide for the following: controller transmits the specified data to the server only under certain condition is fulfilled terminal as this arrangement would facilitate the user to latter download data to his terminal so that user does not have to recreate data that has been erased in the portable terminal as taught by Yamao (col. 2 lines 54-62).

Hasebe differs from claims 15-16 in that he does not specifically teach: data stored in the specified server is downloaded to the storage medium of the mobile terminal apparatus when a second instruction is received from the user, data stored in the specified server is downloaded to a storage means of a second terminal apparatus when a second specified instruction is received from the user.

However, Yamao teaches: data stored in the specified server is downloaded to the storage medium of the mobile terminal apparatus when a second instruction is received from the user (col. 2 lines 54-62).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Hasebe's system to provide for the following: data stored

in the specified server is downloaded to the storage medium of the mobile terminal apparatus when a second instruction is received from the user, data stored in the specified server is downloaded to a storage means of a second terminal apparatus when a second specified instruction is received from the user terminal as this arrangement would facilitate the user to latter download data to his terminal so that user does not have to recreate data that has been erased in the portable terminal as taught by Yamao (col. 2 lines 54-62).

Regarding claim 17, Hasebe teaches the following predetermined keyword (reads on password) is included in the header information of the electronic mail to provide the specified instruction (col. 7 lines 3-19).

Hasebe differs from claim 18 in that although he teaches authenticating the user to be a proper user prior to carrying out security functions in a portable telephone (col. 6 lines 52-48), he does not teach: transmitting specified data.

However, Yamao teaches transmitting specified data to a server from a portable telephone on the basis of instruction sent to the portable telephone (col. 3, line 23 – col. 4, line 32; col. 7, lines 36-45).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Hasebe's system to provide for the following: transmitting specified data as this arrangement would facilitate the user to latter download data to his terminal so that user does not have to recreate data that has been erased in the portable terminal as taught by Yamao (col. 2 lines 54-62).

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe in view of Yamao as applied to claim 5 above, and further in view of Shinkawa (JP2001-309431).

The combination differs from claim 7 in that it does not specifically teach: data erasing processing performed after transmitted to the server is suppressed depending upon type of the data.

However, Shinkawa discloses method of protecting data recorded in mobile terminal, and mobile terminal data protection system which teaches: erasing processing performed after transmitted to the server is suppressed (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: data erasing processing performed after transmitted to the server is suppressed depending upon type of the data in order to conserve computing resources in case data stored in the mobile terminal is of non-critical nature as would be obvious to one of ordinary skill in the art.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melur Ramakrishnaiah/
Primary Examiner, Art Unit 2614

